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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/394,228

09/13/99

PETKOVSEK

G

P-99-012

QM12/1228

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EXAMINER

HENDERSON, M

ART UNIT

PAPER NUMBER

3722

DATE MAILED:

12/28/00

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.  
09/394,228

Applicant(s)  
Glenn Petkovsek

Examiner  
Mark T. Henderson

Group Art Unit  
3722



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 13-20 is/are allowed.

☒ Claim(s) 1-4, 7-9, 11, and 12 is/are rejected.

☒ Claim(s) 5, 6, and 10 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Sep 13, 1999 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference "23" as stated on page 10, line 2, is not shown in the drawings. Correction is required.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because

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reference characters "23" and "13" have both been used to designate a "return receipt postcard".

Correction is required.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "218" has been used to designate both "perforated tear lines" and an "auxiliary label". Correction is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 7-9 and 11, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walz (5,664,725).

Walz discloses in Fig. 1, 4 and 5, a label having a front side (A) and a backside (B) wherein the label (12) includes a postcard (70) and a designator section (73) that is contained within the exterior sides (24a and 26a), a first and second anchor portion (58 and 59) having an adhesive (16) on the backside, and a backing strip (49) disposed over the adhesive on the backside of the anchor (seen in Fig. 5).

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However, Walz does not disclose: a designator section indicative of a special service and has a machine readable code; and a label including shading and printing wherein the shading and printing are a single color.

In regards to **Claims 9 and 11**, the method for preparing a mailpiece for delivery is inherently taught by Walz.

In regards to **Claim 1, 7, 9 and 11**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section and postcard, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

Also in regards to **Claim 1 and 9**, matters related to the choice of ornamentation (color and shading) producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431.

5. Claims 4, and 12, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walz in view of Petkovsek (5,697,648).

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Walz discloses in Fig. 1, 4 and 5, a mailing assembly comprising all the elements as set forth in claims 1 and 9, and as set forth above. Walz also discloses an associated backing sheet (14) attached to the backing strips (49) and the postcard (70).

However, Walz does not disclose a printer track strip associated (Webster Dictionary defines as “combined”) extending outside the exterior sides of the postcard wherein the strip includes a hole and is removably attached to the anchor portion.

Petkovsek discloses in Fig. 5, a mailing assembly having a backing sheet (11) with a printer track strip (56) with holes (54) extending outside the exterior sides of the postcard (18) and is removably attached to the anchor portion (28)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz’s mailing assembly by replacing the backing strip associated with the assembly with a backing strip containing a printer track strip as taught by Petkovsek for the purpose of allowing the mailing assembly to be passed through a printer.

Note, the examiner also submits that the patent reference (Petkovsek) is considered prior art because it had issued more than one year prior to the actual filing date (9/13/99) of the application and application claims 4 and 12 recite subject matter not supported by the parent patent (Petkovsek). Therefore, the claims are not entitled to a date earlier than the actual filing date of this application. See MPEP 2133.01.

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*Allowable Subject Matter*

6. Claims 5, 6 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

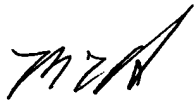
7. Claims 13-20 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses or fairly suggests a mailing assembly comprising a plurality of labels removably attached and includes a postcard, a designator section, and a printer track strip associated with each label wherein the printer tracking strip includes a first hole and each label has a second hole.

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### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

December 14, 2000



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SUPERVISORY PATENT EXAMINER  
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